REMARKS

Claim Status

Claims 1-10 are pending after entry of this paper. Claims 1-10 have been subjected to election of an invention group for prosecution on the merits under 35 U.S.C. §§121. Claims 1-10 have been amended to conform these claims to the U.S. Patent Practice. Support may be found throughout the instant specification and claims. No new matter has been introduced by these amendments.

Response to Restriction Requirement under 35 U.S.C. §121

Claims 1-10 have been subjected to election of an invention group for prosecution on the merits under 35 U.S.C. §121. In the Examiner's opinion, as set forth in the Detailed Action, the application contains inventions or groups of inventions, which are related as product and process of use. The Office Action alleges that the application contains claims directed to two (2) patentably distinct inventions as follows:

Group I: Claims 1-4, and 10, drawn to a method of localization or suppression of a fire, classified in class 169, subclass 43;

Group II: Claims 5-9, drawn to a device for localizing or suppressing fire, classified in class 169, subclass 28.

The applicant respectfully requests that the Restriction Requirement be withdrawn and all claims be examined together on the merits. Nonetheless, in response to the Restriction Requirement, applicants **provisionally elect Group II with traverse**, including **claims 5-9**, drawn to a fire-suppressing device.

The applicant respectfully disagrees with the restriction requirement imposed in the Office Action and the characterizations made of the claimed invention. Accordingly, this

provisional election is made with traverse. It is the Patent Office's position that restriction is appropriate because **Group I** is directed to a method and **Group II** is directed to a product, and allegedly **Group I** method can be practices with a materially different product not defined in **Group II**. (Office Action; pg. 2). The applicant respectfully disagrees.

The applicant wishes to point out that according to M.P.E.P. §803, there are two criteria for a proper requirement for restriction between patentably distinct inventions: (1) The inventions must be independent or distinct as claimed; **and** (2) There must be serious burden on the Examiner if restriction is not required. The applicant respectfully submits that (1) all groups of restricted claims are properly presented in the same application; (2) undue diverse searching would not be required; and (3) all claims should be examined together.

The Patent Office has not shown that examination of all the pending claims would require undue searching and place a serious burden on the Examiner, which is a prerequisite showing for proper issuance of a restriction requirement, since the Examiner has already previously issued an Office Action on merit directed to all the claims (product and process). The applicant also respectfully submits that to search prior art in two subclasses (*i.e.*, 28, 43) within the same class (*i.e.*, 169) cannot be deemed "undue diverse searching." Accordingly, the applicant respectfully traverses the requirement for restriction at least on the grounds that examining the identified groups would not be unduly burdensome.

Furthermore, in making the election request between *product claims* (**Groups II**) and *process of use claims* (**Group I**), the Patent Office followed the procedures as outlined in M.P.E.P. 806.05(h) ("Product and Process of Using - 800 Restriction in Applications Filed Under 35 U.S.C. 111") (Office Action, p 2). However, MPEP 1850 readily states that "[w]hen the Office considers international applications . . . during the national stage as a Designated or

Elected Office under 35 U.S.C. 371, PCT Rule 13.1 and 13.2 will be followed when considering unity of invention of claims of different categories without regard to the practice in national applications filed under 35 U.S.C. § 111." (emphasis added). Applicant respectfully asserts that the Patent Office failed to properly follow the examining procedures outlined in the MPEP with regard to international applications by improperly evaluating the instant claims under the standard applicable only to applications filed under 35 U.S.C. 111. Hence, the restriction requirement is statutorily improper.

Therefore, the applicant respectfully traverses the requirement for restriction because the Patent Office failed to demonstrate that the presently pending claims (1) are unduly burdensome to examine and (2) in light of PCT Rules 13.1 and 13.2, lacked a common technical feature common to all the claims. Therefore, reconsideration and withdrawal of the restriction is respectfully requested to all the claims (1-10), and the examination on the merits are respectfully requested.

CONCLUSION

Based on the foregoing remarks, Applicants respectfully request reconsideration and withdrawal of the restriction requirement imposed on the pending claims and allowance of this application. Favorable action by the Examiner is earnestly solicited.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. **50-4827**, Order No. 1004360.001US.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. **50-4827**, Order No. 1004360.001US.

Respectfully submitted,
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